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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,440	04/22/2004	Richard Herve	016800-632	6323

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BUCHANAN, INGERSOLL & ROONEY PC  
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EXAMINER
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BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/829,440

Applicant(s)

HERVE, RICHARD

Examiner

Venkataraman Balasubramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-23 is/are pending in the application.
- 4a) Of the above claim(s) 5-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicants' response, which included amendment to claims 1, 4 and 23 and cancellation of claims 2 and 3, filed on 5/30/2006, is made of record. Claims 1 and 4-23 are pending. Of which claims 5-22 were withdrawn from consideration in the previous office action but are subjected to rejoinder of claims 5-21 if compound claims 1, 4 and 23 were found allowable.

Claims 1, 4 and 23 are under consideration.

In view of applicants' amendment, 112 second paragraph rejection of claim 4 and 23 has been obviated. As for prior art 103 rejection over Richard et al US 5,236,698, applicants have amended the claim to limit R to tertiary alkyl or cycloalkyl bearing group and have asserted, with a declaration, unexpected superior properties of such tertiary alkyl compounds over secondary alkyl of the reference. Hence, this 103 rejection is deemed as obviated. However, the following apply.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 is indefinite for more than one reason. First of all, the currently amended claim 1 is vague and unclear as to whether it is a genus of compound I or species claim as includes a compound of formula 3 which is a species. As presented, claim 1 recites a

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genus and then appears to select specific compounds but the selection includes a sub genus and a species. Thus, it is not clear what is intended. Secondly, it recites compound of formula I and then shows a compound of formula 3. Thirdly, the entry ii) leaves out the definition of m when  $n=1$  or n when  $m=1$  as well as the definition of R3. One is asked to guess these choices. But to select such compounds one need know what they are. Without knowing these variables one will not be able to make a selection.

2. Claim 4 is an improper dependent claim as it fails to further limit claim 1. Specifically species 1 and 3 recited in claim 4 do not adhere to the definition of R1, R2, R3, R4 and R5 of claim 1. For example, when either n or m is equal to 1, R4 or R5 should be alkyl. In species 1 and 3, there is no alkyl on the "CH<sub>2</sub>" group. Note also when  $n=m=0$  choice also does not permit the species. Hence, the species are outside the scope of claim 1 on which claim 4 is dependent. Also note species 5 is case where  $n=1$  and  $m=1$ . Since claim 1 does not define this situation it is not clear whether this species falls within the scope of claim 1 as to the "CH<sub>2</sub>" group. But this species 5 is definitely outside the scope of claim 1 because when  $n=0$  and  $m=0$ , R1, R2 and R3 are C<sub>1</sub>-C<sub>4</sub> alkyl as per entry (i). Thus the isopropyl group is not permitted by R1= alkyl, R2 =alkyl and R3= H choice.

3. Claim 23 is an improper dependent claim as it fails to further limit claim 1. Specifically species 1 recited in claim 23 does not adhere to the definition of R1, R2, R3, R4 and R5 of claim 1. For example, when either n or m is equal to 1, R4 or R5 should be alkyl. In species 1, there is no alkyl on the "CH<sub>2</sub>" group. Note also when

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$n=m=0$  choice also does not permit the species. Hence, the species 1 is outside the scope of claim 1 on which claim 4 is dependent.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Deletion of the proviso (i) that when  $n=1$  and R4 is hydrogen, then  $m$  is equal to 0, broadens the scope of the claims. Specification on page 4 has the same proviso and hence limits the scope. But the currently presented amendment broadens the scope of the instant invention by the said deletion for which there is no support. Hence, the amendment is deemed as introducing new matter. It should be noted that species can not make a genus unless such a genus is originally intended. Clearly, the proviso in specification and the original claims exclude such a genus.

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

  
Venkataraman Balasubramanian

8/19/2006